REMARKS

Claim 1 is the sole independent claim and stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki '358 ("Sasaki") in view of Nagasaki et al. '730 ("Nagasaki"). This rejection is respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, "the CPU determines whether or not each predetermined processing is performed with use of an external memory." The Examiner admits that Sasaki does not disclose or suggest the aforementioned feature of the present invention. The Examiner therefore relies on Nagasaki as allegedly obviating this deficiency of Sasaki. However, it is respectfully submitted that the cited prior art, alone or in combination, does not disclose or suggest the claimed combination.

Nagasaki discloses a control section 14 which searches the memory card 34 during a non-photographing period (idle time) to read image data and transfer it to the internal memory. As noted by the Examiner, Nagasaki at best discloses only that the control section 14 sends signals to different memory allocations. However, the relied on disclosure of Nagasaki is completely unrelated to the present invention.

As set forth in claim 1, the CPU ***determines*** whether or not each predetermined processing is performed with use of an external memory. The control section 14 of Nagaski does not make any such determination. The control section 14 merely sends the signals to the respective memory locations, but does not determine whether each process uses the alleged external memory or not. Nagasaki does not disclose that the control section 14 first determines whether or not a particular processing utilizes the alleged external memory, then control the processing in accordance with the results of the determination. Rather, the control section 14 simply controls the transmission of the signals to the respective memories per conventional techniques independent of a relationship between a particular process and its usage of an external memory.

As seen for example at S22 shown in Figure 3 of Applicants' drawings, the CPU determines if the external memory is used and based on that determination proceeds to the processing (e.g., preprocessing, zooming, etc.). Accordingly, it can be made possible for the CPU to switch between processing modes in which only the internal memory is used and/or in which both the internal and external memories are used. This switching can be done in accordance with the CPU's determination of whether or not a given processing is performed with the use of the external memory. On the other hand, the control section 14 of Nagasaki merely transfers the data to a memory according to a predetermined protocol without first determining for each process whether it uses a given memory.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejections do not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable.

In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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